

U.S. Serial No. 10/661,748
Filed: September 12, 2003
Amendment and Response to Final Office Action dated 09/22/06

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REMARKS

This Amendment is a full and timely response to the Office Action dated September 22, 2006.

Upon entry of the present amendment, claims 1-58 are pending in this application. Applicant has amended claims 1-14, 17-19, 22, 24, 25, 27-40, 43-45, 48, 50-53, and 56. Applicant has added new claims 57 and 58. No new matter is added by these amendments or new claims, and support for the amendments and new claims may be found throughout the specification and in the original claims.

In the September 22, 2006 Office Action, the Examiner rejected all then-pending claims 1-56. The Applicants respectfully traverse the Examiner's rejections and objection. For the reasons set forth below, the Applicants submit that the objection and rejections should be withdrawn and that the claims are in condition for allowance.

I. Interview Summary

Applicant thanks the Examiner for her time during the interview with Applicant's representatives Michael Turton and Carl Sanders on October 31, 2006. During the interview the parties discussed the rejection of claims 1-56 under 35 U.S.C. § 101. The parties did not reach an agreement regarding overcoming the § 101 rejection of the claims. The parties discussed the Yadav reference, U.S. Publication Number 2004/0186828, and the Examiner agreed that proposed amendments submitted by facsimile to the Examiner on October 26, 2006, if submitted formally, appear to overcome the rejection under § 102 based on the Yadav reference. The parties further

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discussed the Prince reference, U.S. Patent Number 6,877,002. However, the Examiner stated she would need additional time to consider the Prince reference in light of the proposed amendments.

II. New Claims 57-58

Applicants have added new claims 57 and 58. Support for these claims may be found in the specification and claims as originally filed. For example, paragraph 29 of the specification recites criteria that may be used to identify a relationship, such as "consecutive search queries by users previously (whether once or multiple times), queries input by a user within a defined time range (e.g., 30 minutes), a misspelling relationship, a numerical relationship, a mathematical relationship, a translation relationship, a synonym, antonym, or acronym relationship, or other human-conceived or human-designated association, and any computer- or algorithm-determined relationship, but the invention is not limited to any particular relationship." Applicant respectfully submits that new claims 57 and 58 are in condition for allowance.

III. Claim Rejections – 35 U.S.C. § 101

The Office Action rejected claims 1-56 under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. During the interview held on October 31, 2006, the Examiner stated that to render the claims statutory subject matter under 35 U.S.C. § 101, the claims would need to incorporate physical structure for performing the steps of the method, such as, for example, a computer. Applicant respectfully disagrees. Section 101 recites "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may

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obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The methods of claims 1-56 constitute processes, which are statutory by the plain text of § 101. Further, the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* published November 22, 2005 in the Official Gazette state that “the machine implemented test” is “not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter,” but instead, if a claimed invention “produces a useful, concrete, and tangible result.” Thus, whether the processes recited in claims 1-56 are machine implemented is not a proper basis for rejection under 35 U.S.C. § 101, and instead, whether the methods produce a “useful, concrete, and tangible result” is a proper inquiry.

The Federal Circuit has held that for a claimed invention to satisfy the requirements of 35 U.S.C. § 101, it must produce a “useful, concrete, and tangible result.” *State St. Bank & Tr. Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373-74 (Fed. Cir. 1998). In its *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, the USPTO states that the Examiner should weigh the aforementioned factors to determine whether 35 U.S.C. § 101 is met. *See Interim Guidelines*. Applicants have amended claims 1, 27, and 53 to include the step of “outputting a search result comprising the first article.” The outputting of a search result comprising a first article is a useful, concrete, and tangible result, and thus, claims 1, 27, and 53 claim statutory subject matter. Because the Applicants’ invention meets each of the three factors, as explained below, claims 1-56 are patentable under 35 U.S.C. § 101.

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A. Useful

First, the Applicants' claimed invention is useful. Searching is a function performed daily through the use of search engines on the Internet or World Wide Web, within an application on a user's computer, or any other area where only a specific part of a large amount of information is desired. A user may employ a search engine to find documents, articles, database records, or other information related to the user's search query. The results of the search may then be presented to the user to enable her to more quickly access the desired information. Thus, searching and outputting search results is a useful function that is widely recognized and used in a large number of contexts.

For an invention to be useful within the meaning of 35 U.S.C. § 101, the Patent Office requires a claimed invention's utility to be "specific, substantial, and credible." See M.P.E.P. § 2107(II)(A)(3); *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*. The M.P.E.P. describes a "specific and substantial utility" as excluding "throw-away," "insubstantial," and "nonspecific" utilities. § 2107(II)(B)(1)(i). The Applicants' claimed invention cannot be categorized as any of these three types of exclusions. Rather, it has the specific utility of improving the ranking of articles within search results and outputting more relevant search results.

The claimed invention meets these minimal thresholds set forth by the U.S. Patent Office for at least the reasons set forth in the first paragraph of this section: searching and outputting search results allows a user to find specific relevant information within a large pool of documents, articles, or other types of information. Therefore, the Applicants' claimed invention is useful, because it has a specific and substantial utility.

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B. Concrete

Second, the Applicants' claimed invention is concrete. For this factor to be met "the process must have a result that can be substantially repeatable or the process must substantially produce the same result again." *Interim Guidelines*. The Applicants' claimed invention meets this criterion because a search result is output for each search query received. Therefore, the Applicants' claimed invention is concrete, because it produces a result that is substantially repeatable.

C. Tangible

Third, the Applicants' claimed invention is tangible. This requirement "does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing." *Interim Guidelines*. Rather, the claim must set out a "practical application" that produces a "real-world result." *Id.* The Applicants' claimed invention sets out a practical application in claims 1, 27, and 53 (and, thus, to their respective dependent claims) by outputting a search result comprising the first article, a practical result used by web and other document searchers every day. Thus, because the Applicants' claimed invention has a practical application and produces real-world results, the claimed invention is tangible.

Therefore, because each of the three criteria for patentability under § 101 are met, claims 1-56 are directed towards patentable subject matter. Applicant respectfully requests the Examiner withdraw the rejection of claims 1-56.

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IV. Claim Rejections – 35 U.S.C. § 102

Applicant respectfully traverses the rejection of claims 1-53 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent Application Publication No. 2004/0186828 to Yadav (hereinafter referred to as “Yadav”).

To anticipate a claim under 35 U.S.C. § 102(e), “the reference must teach each and every element of the claim.” M.P.E.P. § 2131.

Because Yadav does not disclose “receiving a first search query; receiving a second search query; [and] determining a relationship between the first search query and the second search query” as recited in amended claim 1, Yadav does not anticipate claim 1. Yadav discloses modifying a user’s search query to create an enhanced query by including synonyms and related terms. The enhanced query is then submitted to one or more search engines. However, Yadav does not disclose receiving first and second search queries, and determining a relationship between the first and second search queries. Yadav only discloses the use of a single search query. Thus, Yadav does not anticipate claim 1. Applicant respectfully requests the Examiner withdraw the rejection of claim 1.

Like claim 1, claim 27 recites “determining a relationship between the first search query and the second search query.” For at least the same reasons that Yadav does not anticipate claim 1, Yadav does not anticipate claim 27. Applicant respectfully requests the Examiner withdraw the rejection of claim 27.

Because claims 2-26 and 28-52 depend from and further limit claims 1 and 27, respectively, Yadav does not anticipate claims 2-26 and 28-52 for at least the same

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reasons as claims 1 and 27. Applicant respectfully requests the Examiner withdraw the rejection of claims 2-26 and 28-52.

V. Claim Rejections – 35 U.S.C. § 102(e)

Applicant respectfully traverses the rejection of claims 53-56 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,877,002 to Prince (hereinafter referred to as "Prince").

To anticipate a claim under 35 U.S.C. § 102(e), "the reference must teach each and every element of the claim." M.P.E.P. § 2131.

Because Prince does not disclose "receiving a first search query; receiving a second search query; [and] determining a relationship between the first search query and the second search query" as recited in amended claim 53, Prince does not anticipate claim 53. Prince teaches a system for compiling metadata relating to files in order to build a database to enhance search performance. Prince, *inter alia*, does not teach receiving a first and second search query, and determining a relationship between them. Thus, Prince does not anticipate claim 53. Applicant respectfully requests the Examiner withdraw the rejection of claim 53.

Because claims 54-56 depend from and further limit claim 53, Prince does not anticipate claims 54-56 for at least the same reasons. Applicant respectfully requests the Examiner withdraw the rejection of claims 54-56.

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CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action of September 22, 2006. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an amendment, please call 404 815 6061.

Respectfully submitted,



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